



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,563	06/27/2003	Donald J. Kyle	6750-173-999	5149
20583	7590	10/20/2006	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			WARD, PAUL V	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,563

Applicant(s)

KYLE ET AL.

Examiner

PAUL V. WARD

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-190 is/are pending in the application.
- 4a) Of the above claim(s) 23-101 and 106-190 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-22 and 102-105 is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Applicant's election, with traverse, of Group I and the compound BVQ, in the reply filed on July 24, 2006 is acknowledged. The traversal is on the grounds that Groups VI and VII be combined and examined, Groups VIII-XIV be combined and examined, Groups XV-XXI be combined and examined, and XXII-XXVIII be combined and examined. This argument is not found persuasive to overcome Examiner's Restriction because Groups I-XXVIII are separate and patentably distinct since there is no patentable co-action among them. For example, when examining the compounds of formula I or when examining the compounds of formula IXV, a reference anticipating one will not render the other obvious. Hence, Applicant's inventions are distinct and have acquired a separate status in the art due their recognized divergent subject matter and different classification. Additionally, a large amount of non-patent literature contained in various databases must also be searched in order to find the most pertinent prior art. A search of the twenty-eight groups would impose an undue burden upon the Examiner. Thus, the restriction for examination purposes as indicated is proper.

The requirement is still deemed proper and is therefore made **FINAL**.

Applicant is entitled to have the method claims, which are commensurate in scope with the elected invention, rejoined. An amendment, which results in the method claims being commensurate in scope with the allowed claims, will be welcomed.

Group II-XXVIII is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Please note that each composition claim (e.g., claims 102-116) will be examined with each respective compound claim.

Applicant reserved the right to file a divisional application to the non-elected subject matter.

An action on the merits of Group I (claims 1-22 and 102-105) is contained herein.

Conclusion

This application is in condition for allowance except for the presence of non-elected subject matter in the claims.

The compounds and composition, in Group I, were neither found to be obvious nor anticipated by the prior art of record. The prior art does not teach or suggest the presently claimed compound.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

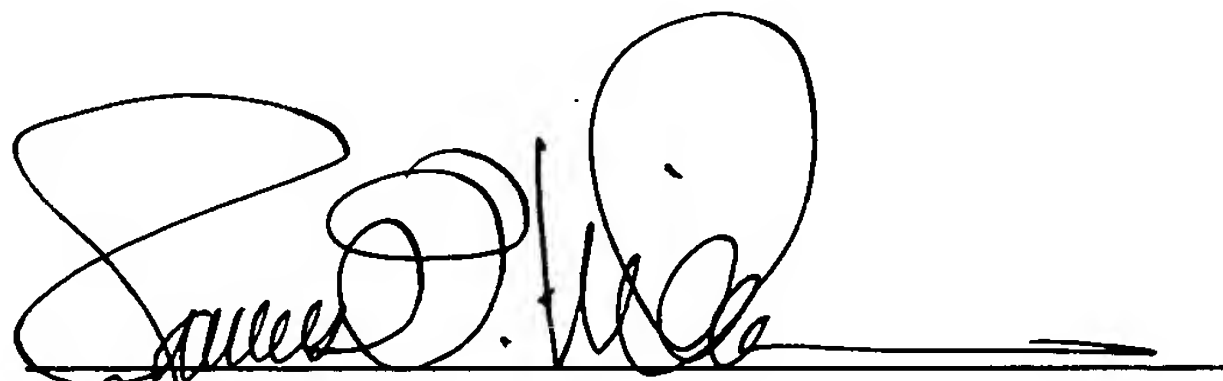
A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Art Unit: 1624

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL V. WARD whose telephone number is 571-272-2909. The examiner can normally be reached on M-F 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James O. Wilson
Supervisory Patent Examiner,
Technology Center 1600